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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/609,263	06/26/2003	Benjamin N. Eldridge	P150D1-US	8103
50905	7590	11/14/2005	EXAMINER	
N. KENNETH BURRASTON KIRTON & MCCONKIE P.O. BOX 45120 SALT LAKE CITY, UT 84145-0120			KIM, PAUL D	
			ART UNIT	PAPER NUMBER
			3729	

DATE MAILED: 11/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/609,263

Applicant(s)

ELDRIDGE, BENJAMIN N.

Examiner

Paul D. Kim

Art Unit

3729

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 22-57 is/are pending in the application.
- 4a) Of the above claim(s) 41-46, 48-51 and 54 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 22-40, 47, 52, 53, and 55-57 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

This is a response to the election of species filed on 9/1/2005.

#### ***Response to the Election of Species***

1. Upon further review, examiner agrees with the applicant's argument in part, the election of species as set forth mailed on 8/1/2005 is hereby withdrawn.
2. Since the claims 22-40 have been examined previously mailed the first office with the "Double Patenting" rejection on 2/14/2005, the claims 22-40 should be pending. In addition to that, the claim 47 should be included to the pending claims and the non-elect claims 41-46 have been withdrawn. Also, the status of the newly submitted claims 48, 49 and 54-57 should be changed from "(withdrawn)" to --(new)--.
3. According to the amendment filed on 5/18/2005 with the "Terminal Disclaimer", newly submitted claims 48-57 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

The claim 48 is a dependent claim of the withdrawn claim 41. Therefore the claim 48 should be withdrawn.

The claim 49 is a dependent claim of the withdrawn claim 44. Therefore the claim 49 should be withdrawn.

The claims 50 and 51 have a distinct limitation from the invention originally claimed such as "if said module passes said testing, repeating said testing step at a newly selected operating speed". The originally claimed invention for claim 40 recites, "if said module passes said testing, removing said integrated circuits from said module

substrate, and permanently securing the integrated circuits to a second module substrate". Therefore, the claims 50 and 51 are withdrawn from consideration as being directed to a non-elected invention.

The claim 54 also has a distinct limitation from the invention originally claimed such as "if said module passes said testing, rating said module... speed". Since the originally claimed invention for claim 40 recites as set forth above, therefore, the claim 54 is also withdrawn from consideration as being directed to a non-elected invention.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 48-51 and 54 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

4. The newly submitted claims 52, 53 and 55-57 contain claims directed to the following patentably distinct species of the claimed invention:

Species A, drawn to determine a number of the integrated circuits attached to the module substrate that caused the module to fail the testing for claims 52 and 53.

Species B, drawn to determine a number of times the module has failed the test at the selected operating speed for claims 55-57.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 22 is a generic claim.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

5. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul D. Kim whose telephone number is 571-272-4565.

The examiner can normally be reached on Monday-Friday between 7:00 AM to 3:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on 571-272-4690. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Paul D Kim  
Examiner  
Art Unit 3729